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EXAMINER

BAYERL, RAYMOND J

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2173

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,608

Applicant(s)

SMITH, MILTON

Examiner

Raymond J. Bayerl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>29jun04</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 41 – 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In new independent claim 41, “the kiosk” at line 3 appears without clear antecedent basis, as it might in the alternative claim 24, which is actually directed to “A kiosk”.

Also, in new claim 44, “the included attribute” appears without clear antecedent basis in parent claim 41. It is only in non-parent claim 43 that “an attribute” is recited.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 - 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A “computer program” as in amended independent claim 1 that comprises merely a number of specified “module” components is a computer program *per se*, in that it is not fixed to a tangible computer readable medium, computer hardware, etc. It does not matter that, in the preamble, it is indicated that the “program” is “executed on one or more processors”, since the “processors” do

not form an actual part of the claimed invention. The four statutory classes of invention under 35 USC 101 do not provide for such a claim.

Please note that the form of “A computer-readable medium having embodied thereon a computer program” is statutory as it appears in amended claim 13, since the “computer-readable medium” is an actual part of the claimed invention.

4. Claims 1 – 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey et al. (“Frey”; US #6,369,908 B1) and Yager et al. (“Yager”; US #5,983,236).

As per independent claim 1’s use of “a processing module for carrying out image processing” for the purpose of “outputting the image in at least one of” a “second plurality of different image file formats”, please note that Frey’s PHOTO KIOSK similarly discloses that a cpu is used to capture an electronic image, to which the user can selectively add to the electronic image and save the electronic file on a removable electronic storage device (Abstract). This storage device, as indicated at col 1, lines 60 – 64, can be a computer diskette, CD, tape or similar item. Responsive to a “user-generated service request” (see col 3, lines 19 – 42), the captured image is sent to the cpu (col 3, lines 43 – 67), which displays the captured image onto the monitor 13, thereby allowing the user to review the captured image. From the display format, Frey must convert to one of the disparate “image file formats” for the particular storage device that is selected.

Frey's **explicit** disclosure appears to be that of a single-source image acquisition arrangement, via a digitizing camera at the KIOSK location, and not one that uses "an input module for receiving images in a first plurality of different image file formats" for conversion to the "common image file format" of the monitor.

However, Yager, in PROVIDING A MULTIMEDIA PRESENTATION, works with combinations of audio, video, still images, and text which are represented by binary data files (Abstract). In so doing, any of the various audio, video, still image and text data formats is supported. As described at col 3, lines 7 – 25, in building a data file from component data, a file type identifier is associated with the synchronized output (see also col 2, lines 42 – 65).

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to develop a formatted output from a common, internal format for image processing, as per Frey, but while sourcing the image data from a variety of input formats as per Yager, for this expands the potential for a Frey user to develop a useful finished product, as with a KIOSK that supports a user interface. The Frey user is not limited to the single image capture medium of the camera, but can obtain files from a server-based environment (Yager, col 1, lines 47 – 61).

As per claims 2, 16 the Examiner notes that the "first conversion module" operates with "one of the first plurality of different image file formats", which in claim 2 are limited so as to "include" a list of industry-standard image storage formats. Yager reads upon a claim so constructed, by disclosing a decoder of

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still image data adapted for use with the GIF, TIF, or BMP formats, which could be substituted for the JPEG decoder of the present embodiment (col 7, lines 37 – 60).

Similarly, when claim 3 elaborates upon “at least one of a second plurality of different media”, presenting a list of optional formats in so doing, it still reads upon the CD, floppy disks, and the like that are supported by Frey. A similar line of reasoning applies to claim 6.

As per claims 4, 18, 35 the “image processing performed by said processing module” that “includes...”, followed by a listing that includes “previewing corrected images”, on the basis of “at least one corresponding user-generated service request”, can be reasonably interpreted to read upon the cpu in Frey, which displays the photographic image with the superimposed banner on the monitor (col 4, lines 23 – 32). This “service request”, as seen in Frey, is “via a plurality of screen displays” on the monitor (claim 7), and may constitute at least “a new order” and an “image display” (claim 8). In Frey’s operation, “images are stored by said computer program” locally, before their ultimate disposition (claim 11), and the composition thereby created and implemented, as also in the case of Yager’s output, is “an order file” (claims 12, 20, 23).

Claim 5’s “second plurality of different image file formats”, of which an option is “JPG...” (see also claim 17), is suggested by the file-assimilation of JPEG still image data format sources in Yager, should they be incorporated into the recorded output in combination with Frey.

As per the “network connected” “user” of claim 9, please note further that Frey specifically works with electronic transmission, such as over the Internet or other similar network of computers (col 1, lines 54 – 59). The KIOSK of Frey may be remotely accessed (col 6, lines 34 – 40). As further seen in Yager’s use of a remote digital computer system that interacts with a server (col 2, lines 16 – 41), it can be seen that “image processing” functions were routinely performed over a “network” at the time of applicant’s invention. A similar line of reasoning applies to the “remote terminal” of claim 10.

The Frey/Yager combination, in which disparately-sourced images are composited into an output having a specific format, requires that the “computer program” responsible will appear as “an article of manufacture” (independent claim 13), provided “as a propagated signal” (claim 14).

New independent claim 15, in developing a “common image file format” representation from a “first image file format” also reads upon the input conversion that is obvious, when Frey’s processing is upon Yager’s multiple sourcing. Frey’s “user-generated service request” then directs output in a “second image file format”, as noted above. The Frey user is in charge of “functions to be executed by the image processing step”, as in claim 19.

Given Yager’s teachings of distributed processing and remote operation, a Frey processor, which may be remotely accessed, can then receive “the image and service request via a network” (claims 21, 22), as in the case of the internet connected Frey customer who is identically shown as receiving the output in a format like e-mail.

The “kiosk” of claim 24 is presented somewhat more broadly than the “image file format”-based embodiments recited in the earlier independent claims. Here, “inputting one or more images” is at least to be found in Frey, who also teach “a service request input device” capability. The matter of “sending the one or more images and the order file to a second processing device” is then suggested by the multiple-terminal arrangement of Yager: it would have been obvious as well to the person having ordinary skill in the art at the time of applicant’s invention to divide the processing functionality of image sourcing and instruction gathering from processing, “to satisfy the corresponding one or more service requests”. The motivation to use an approach like Yager’s server set-up resides in Frey, where the destination for the “images” is already placed upon a separate server, when the customer wishes e-mailed copies. In Frey, the end-user, at the other location, has additional processing beyond capture and transmission, which the user may then conduct at that location. Yager, superimposed upon this, will treat the Frey “kiosk” as a server, and then perform the “processing” on the “second processing device” so as to generate the final MULTIMEDIA PRESENTATION.

At the “second processing device”, then, of the Frey/Yager combination, “outputting of the one or more images” will take place (claim 25). In receiving “service requests” from the Frey “kiosk”, “attributes associated with the specified output device” (claims 26, 43) will necessarily be transmitted over a “communicative link” (claims 40, 46, 47) as “preferences” (claim 36), as is identically seen when Frey specifies output modes for the images captured.

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These will include the "output image file format" (claim 27) and "output media" (claim 28), as instructed from the higher-order Frey device. Included are at least "a digital storage device", to satisfy claim 29, and "output" "on the specified medium" (claim 30).

At the point that the "customer" directs a Yager-enhanced Frey "kiosk", "customer information" includes at least one of "price, and method of payment" (claim 31), or the transaction cannot proceed. Frey, as noted above, allows specification of "an address" (claim 32) of "a digital storage device" (claim 34) using a "file directory" (see also claim 38, 45), and a principal finished "medium" in such an environment as photo-imaging is "a print medium" involving at least "border information" (claim 33, 44). In this scenario, "print sizes" are also specified (claim 37). In the alternative, the components can be located together, as in claim 39; indeed, this is a feature of a "kiosk" such as Frey's, in creating immediate added value at a given site.

Independent claim 41 is rejected for reasons similar to those given for the rejection of claim 24 above. The "image file format" conversion of claim 42 then reads upon the conversion treated above in the rejection of claim 1.

5. Applicant's arguments filed 22 June 2004 have been fully considered but they are not persuasive.

Regarding the Section 101 rejection, repeated above for claims 1 – 12, applicant argues (page 21) that the "computer program executed on one or more processors" is such that "the claimed subject matter is directed to a computer program, which has a functional interrelationship to computer hardware".

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However, within the actual claim, the potential that it is “executed on one or more processors” does not remove it from the difficulty of being a program *per se*.

Concerning the application of Frey, applicant argues (pages 22 – 23) that “Frey’s disclosed conversions of an image between a memory format, a display format and a storage medium format is fundamentally different than the conversion of an image file format of an image”. However, it remains that the conversion to output data in Frey is from the “common” format of the processor to another “image file format” such as that recorded on a medium or transmitted over the internet to the customer’s e-mail address.

The use of Yager is then contested by applicant at page 23, with the argument that “Yager does not disclose, nor does the Examiner suggest that Yager discloses, converting any of the image file formats associated with the selected video clip”. However, Yager, in working with plural sources of image and media content, **does** require conversion at input, and the Examiner in fact **does** suggest as much.

Concerning the combination of Frey and Yager, applicant argues (page 24) that “one of ordinary skill in the art would not have been motivated to combine the teaching of Frey and Yager” because they “are not analogous prior art”—“Frey is directed to a kiosk for capturing still images of a user, while Yager is concerned with allowing a user to select video clips from a server”. However, the person of ordinary skill in the art would immediately appreciate Yager’s applicability to the handling of diversely-sourced still image content, for assimilation into a final presentation, with the problem faced in Frey, when one

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wishes to extend the capability of an imaging device that must produce a user-desired aesthetic result. The two references therefore contain relevant analogy and the combination is proper.

Applicant supplies no substantive argument concerning the patentability of new claims 15 – 47, but as indicated above, these variants are also obvious over the Frey/Yager combination. Specifically, dividing image sourcing from processing is a principal feature of Yager, and one from which will follow such adaptations as dividing the local and remote portions of the customer order satisfaction as seen in new independent claims 24, 41.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

During an update search, the Examiner noted additional US Patent documents relevant to the area of imaging customer order placement, as seen on the attached form PTO-892.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will


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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (703) 305-9789 through the month of October 2004 and (571) 272-4045 thereafter. The examiner can normally be reached on M - F from 10:00 AM to 5:00 PM ET.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116 through the month of October 2004 and (571) 272-4048 thereafter. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173
14 October 2004